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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,426

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Edward B. Knudson

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ROPES & GRAY LLP
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EXAMINER

ATALA, JAMIE JO

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/627,426		KNUDSON ET AL.	
	Examiner		Art Unit	
	JAMIE JO VENT ATALA		2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed August 6, 2008 have been fully considered but they are not persuasive. On pages 8-9 applicant argues that Horlander et al in view of Wonfor et al fails to disclose, suggest, or teach the following limitations: "means for removing the copy protection from the selected program" as recited in Claim 5. It is taught by Wonfor in Column 4 Lines 50-67 through Column 5 Lines 1-48 the system determining the copy protection associated with each program. When the system determines copy protection is applied to the program the picture will be un-viewable (Column 5 Lines 45-47); however, if the copy protection is paid for properly to the rights holder than the copy protection is lifted on the program and thereby the user becomes an authorized user (Column 5 Lines 1-28). Thereby teaching the removal of copy protection from the program. It is noted applicant argues that the copy protection process is not applied to a program being delivered for recording; however, the claim recited the selected program is for viewing or recording. Although, all of applicants points are understood the examiner can not agree and therefore the rejection is maintained.

2. Claims 5-12 are currently pending. Claims 1-4 have been cancelled on August 6, 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horlander et al (7,017,171) in view of Wonfor et al (US 6,381,747).

[claim 5]

Regarding claim 5, Horlander discloses the claimed limitations of claim 5, including providing the selected program without copy protection (see col31, lines 53-58 and col.32, lines 52-56) here if it is legal to copy the bit stream the source device instructs the VCR to turn on its DAV receiver and to go into the record mode, and additionally DSS checks the copy protect mode of the video bit stream and determines if it is permissible to make a copy. If digital copies are permitted then the default device hails for the DAV bus.

Horlander fails to explicitly disclose means for displaying the interactive television program guide, and means for removing the copy protection from the selected program.

Wonfor et al teach a method of controlling copy protection in digital video networks where it is desired to copy protect an analog or digital video output signal associated with a digital video network, comprising displaying the interactive television program guide (see col.3, lines 8-10), and removing the copy protection from the selected program (see col.7, line 60 to col.8, line 8). Displaying the interactive television

program guide provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and removing the copy protection from the selected program provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs.

It, therefore, would have been obvious to modify Horlander by realizing Horlander with the means for displaying the interactive television program guide, as taught by Wonfor, since this provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and also would have been obvious to modify Horlander by realizing Horlander with the means for removing the copy protection from the selected program, as taught by Wonfor, since this provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs, for example.

Furthermore, Horlander fails to explicitly disclose means for offering the selected program for purchase at a price for the program without copy protection when the program is selected for recording, means for offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing, and means for providing the selected program with copy protection when the program is purchased at the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

[claim 6]

Regarding claim 6, Horlander et al and Wonfor et al fail to explicitly disclose wherein the price for the program without copy protection is more than the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on circuit at hand.

[claim 7]

Regarding claim 7, the claimed limitations of claim 7 are accommodated in the discussions of claim 5 above.

[claim 8]

Regarding claim 8, the claimed limitations of claim 8 are accommodated in the discussions of claim 6 above.

[claim 9]

Regarding claim 9, the claimed limitations of claim 9 are accommodated in the discussions of claim 5 above; except, wherein the control circuitry directs the tuner circuitry to tune to the selected program with copy protection (see Horlander et al, col.4, lines 44-50, and col.13, lines 13-23). Horlander and Wonfor fail to explicitly disclose wherein the control circuitry is configured to direct the display circuitry to display a message offering the user the selected program for purchase at a price for the program without/with copy protection when the program is selected for recording/viewing, respectively. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

[claim 10]

Regarding claim 10, the claimed limitations of claim 10 are accommodated in the discussions of claim 6 above.

[claim 11]

Regarding claim 11, the claimed limitations of claim 11 are accommodated in the discussions of claim 5 above.

[claim 12]

Regarding claim 12, the claimed limitations of claim 12 are accommodated in the discussions of claim 6 above.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE JO VENT ATALA whose telephone number is (571)272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMIE JO VENT ATALA/
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621